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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,826	04/21/1999	TODD R. COLLART	1A 1508.01A US	7629

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92614

EXAMINER

WINTER, JOHN M

ART UNIT PAPER NUMBER

3621

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/295,826

Applicant(s)

COLLART, TODD R.

Examiner

John M Winter

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ML

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Status

Claims 1-20 are presently pending

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

The Applicants arguments filed on March 23, 2004 have been fully considered but are not persuasive.

The Applicant states that the Gracernote, Archibald, Oshima and Hellman references do not render obvious combining user information from a server database with BCA information to trigger a transaction for payment.

The Examiner states that this feature is disclosed by the reference Oshima (US Patent 6,081,785). See following rejection.

The Examiner states that the Rosen reference has been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,8,10,11-16,18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gracernote.com (New Media pioneers Ann Greenberg and Ty Roberts join CDDB.Com) in view of Archibald et al. (US Patent 5,825,883) and in further view of Hellman (US Patent 4,658,093) and in further view of Oshima (US Patent 6,081,785).

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As per claim 1,

Gracernote.com discloses a method for permitting selective access to data, comprising; Gracernote.com does not explicitly disclose collecting a payment for use of content on the electronic storage medium Archibald et al. ('883) discloses collecting a payment for use of content on the electronic storage medium. (figure 14) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Archibald et al method in order to collect a payment for use of content on the electronic storage medium in order to reduce the amount of revenue lost because of rampant piracy of digital materials.

Gracernote.com does not explicitly disclose reading burst cut area (BCA) information stored on a electronic storage medium. Oshima et al. ('785) discloses reading burst cut area (BCA) information stored on a electronic storage medium(Column 3 lines 35-67, column 4 lines 1-14) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Oshima et al. ('785) method in order to prevent unauthorized usage of digital content.

Gracernote.com does not explicitly disclose verifying the BCA information in a separate database. Oshima et al. ('785) discloses verifying the BCA information in a separate database (Column 5, lines 8-22) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Oshima et al. ('785) method in order to prevent unauthorized usage of digital content.

Gracernote.com does not explicitly disclose combining user information from a server database with BCA information to trigger a transaction for the payment. Hellman. ('093) discloses combining user information from a server database with BCA information to trigger a transaction for the payment. (Figure 5 –shows billing , also Column 10, lines 33-65 – shows trigger logic) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Hellman method in order to collect a payment for use of content on the electronic storage medium in order to reduce the amount of revenue lost because of rampant piracy of digital materials. Although Hellman does not specifically disclose using the BCA information it would have been obvious to combine the Hellman method with the Oshima et al. method (Column 5, lines 66-67 – column 6 lines 1-34) in order to achieve the claimed invention.

Claim 11 is in parallel with claim 1.

As per claim 2,

Gracernote.com discloses the method as recited in claim 1, wherein the identifier is verified in the separate database after the user effects a remote link between the computer and the separate database. (Gracernote.com, paragraph 7)

Gracernote.com does not explicitly disclose the BCA information is verified in a separate database. Oshima et al. ('785) discloses the BCA information is verified in a separate database (Column 5, lines 8-22) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Oshima et al. ('785) method in order to prevent unauthorized usage of digital content.

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Claim 12 is in parallel with claim 2.

As per claim 3,

Gracernote.com discloses the method as recited in claim 1,

Gracernote.com does not explicitly disclose wherein logic tailors video based information. Archibald et al. ('883) discloses wherein logic tailors video based information (column 6, lines 33-47) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Archibald et al method of combining identifier information associated with the identifier and user information associated with the user in order to simplify record keeping procedures by merging customer and transaction data.

Gracernote.com does not explicitly disclose the BCA information is read. Oshima et al. ('785) discloses the BCA information is read (Column 3 lines 35-67, column 4 lines 1-14) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Oshima et al. ('785) method in order to prevent unauthorized usage of digital content.

Claim 13 is in parallel with claim 3.

As per claim 4,

Gracernote.com discloses the method as recited in claim 1,

Gracernote.com does not explicitly disclose storing a record of the transaction in a database. Archibald et al. ('883) discloses storing a record of the transaction in a database (column 6, lines 48-59; also figure 3) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Archibald et al method of storing a record of the transaction in a database in order to simplify record keeping procedures.

Claim 14 is in parallel with claim 4.

As per claim 5,

Gracernote.com discloses the method as recited in claim 2,

wherein the computer is remotely coupled to the separate database via a network.
(Gracernote.com, paragraph 7)

Claim 15 is in parallel with claim 5.

As per claim 6,

Gracernote.com discloses the method as recited in claim 5.

Gracernote.com does not explicitly disclose the payment processing is conducted electronically in a secure manner. Archibald et al. ('883) discloses the payment processing is conducted electronically in a secure manner. (column 6, lines 48-67) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the

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Gracenote.com method with the Archibald et al method of processing payments in a secure manner in order to promote consumer confidence by protecting sensitive account information.

Claim 16 is in parallel with claim 6.

As per claim 8,

Gracenote.com discloses the method in claim 1.

wherein electronic storage medium is an optical disc. (Gracenote.com, paragraph 7)

Claim 18 is in parallel with claim 8.

As per claim 10,

Gracenote.com discloses the method in claim 1,

wherein the data is stored in a remote database. (Gracenote.com, paragraph 7)

Claim 20 is in parallel with claim 10.

Claims 7,9,17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gracenote.com (New Media pioneers Ann Greenberg and Ty Roberts join CDDDB.Com) in view of Archibald et al. (US Patent 5,825,883) and further in view of Oshima et al (US Patent 6,081,785) and in further view of Hellman (US Patent 4,658,093) and in further view of Rosen (US Patent 5,953,423).

As per claim 7,

Gracenote.com discloses the method as recited in claim 5,

Gracenote.com does not explicitly disclose an electronic code is utilized to authorize use of the content on the electronic storage medium. Oshima et al ('785) discloses an electronic code is utilized to authorize use of the content on the electronic storage medium. (Figure 24b) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracenote.com method with the Oshima et al ('785) method of using an electronic code to authorize use of content on an electronic storage medium in order prevent piracy of digital materials.

Claim 17 is in parallel with claim 7.

As per claim 9,

Gracenote.com discloses the method as recited in claim 8.

Gracenote.com does not explicitly disclose the burst cut area information is an identifier of the optical disc. Oshima et al ('785) discloses the burst cut area information is an identifier of the optical disc. (column1, lines 36-50; also figure 18) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracenote.com method with the Oshima et al ('785) method of storing an identifier on a burst cut area of the optical in order prevent piracy of digital materials.

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Claim 19 is in parallel with claim 9.

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Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
May 31, 2004



JAMES P TRAMMELL
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